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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,577

10/10/2006

Atsushi Hamada

2006\_0508A

9303

513 7590 03/17/2010  
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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

03/17/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
coa@wenderoth.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,577	<b>Applicant(s)</b> HAMADA ET AL.	
	<b>Examiner</b> VICTOR S. CHANG	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/22/09, 11/1/07, 8/7/06, 4/4/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION*****Election/Restrictions***

1. Applicant's election without traverse of Species A of hydrogen (H) for R1 and Species B of platinum-1,3-divinyl-1,1,3,3-tetramethyldisiloxane in the reply filed on 12/10/2009 is acknowledged.

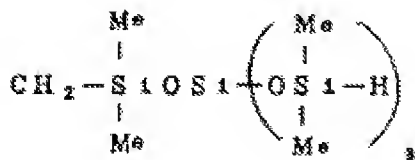
***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02-151677 (English Abstract).

JP '677 relates to an adhesive composition produced by mixing 1) an alkenylated polyether (e.g. allyl glycidyl ether/ethylene oxide copolymer) of an average MW of 10000-5000000, 2) 0.1-10000ppm a platinum compound catalyst, and 3) a Si-H-containing polyorganohydrogensiloxane, e.g.,



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See page 605. The adhesive composition is formed by curing the components with hydrosilylation reaction.

For claims 1-3, JP '677 Abstract teaches all the features of the molecular structures of the adhesive composition as claimed. JP '677 Abstract is silent about forming an adhesive sheet laminate on a substrate. However, the examiner takes Official notice that depositing an adhesive composition on a substrate to form an adhesive material is common knowledge, it would have been an obvious modification to one of ordinary skill in the art to do so, motivated by the desire to obtain the convenience of applying the adhesive for end use. Regarding the adhesiveness of the composition, it is deemed to be inherent to the same chemistry. Regarding the use limitation (for skin adhesion), since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

For claims 6 and 7, JP '677 Abstract teaches that in general alkenylated polyether can be used, and illustrated at page 605 alternative polymeric main chains of polyoxyethylene and polyoxybutylene. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art to select polyoxypropylene as well. It should be noted that the measurement of molecular weight "in polystyrene conversion" is interpreted as measuring the molecular weight by a size-exclusion chromatography which has been calibrated by polystyrene standards. While JP '677 is silent about the standards used for molecular weight measurement, JP '677 does teach a molecular weight range which overlaps and therefore reads on the claimed molecular weight range in claim 7.

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For claim 8, since JP '677 teaches generally the same chemistry of making the adhesive for the same end use, workable degree of curing by hydrosilylation reaction, and therefore the resultant toluene-insoluble cured component in the composition is deemed to be obvious routine optimization to one of ordinary skill in the art, motivated by the desire to obtain the required adhesiveness by curing for the same end use as the claimed invention.

For claim 9, for the same reasons set forth above, the moisture permeability is deemed to be inherent to the same chemistry as the claimed invention.

For claims 4, 5, 10 and 11, JP '677 is silent about the use of platinum-vinyl siloxane complex as the catalyst for the hydrosilylation reaction. However, the examiner takes Official notice that platinum-vinyl siloxane complex is common and well known for hydrosilylation reaction, absent any unexpected results, the selection of a known catalyst for intended reaction is deemed to be obvious to one of ordinary skill in the art. Further, the genus platinum-vinyl siloxane complex clearly encompasses the various species, including platinum-1,3-divinyl-1,1,3,3-tetramethyldisiloxane.

### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 6:00 am - 4:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794